IN THE UNITED STATES PATENT AND TRADE MARK OFFICE

Applicant: Gibson, Rodney Mark
Application Serial No: 10/553,290
Title: Building Construction
Filing Date: November 17, 2005
Mail Stop: AF (APPEAL)

Examiner: Jessica L Laux
Art Unit 3635

BRIEF ON APPEAL

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BRIEF ON APPEAL

Honorable Commissioner for Patents

PO Box 1450, Alexandria, VA 22313-1450

Dear Sir

This Brief on Appeal is being filed under 37 C.F.R 41.37 in support of the Notice of Appeal filed on August 26, 2010, under 37 C.F.R 41.31 in response to the examiner's final rejection of April 26, 2010. Thus, the Brief on Appeal was due on or before October 26, 2010. This response is filed on October 5, 2010 and is thus timely filed. Appellant hereby submits an original copy of this brief on Appeal to the Board of Patent Appeals and Interferences. The brief on Appeal is accompanied by authorization to

charge the fee due therewith to the designated deposit account (Deposit account number: 50-3321).

I. REAL PARTY IN INTEREST

The real party in interest in the subject matter of this application is the inventor Mr. Rodney Mark Gibson.

II. RELATED APPEALS OR INTERFERENCES

There are no related appeals or interferences pending and appellant is not aware of any previous appeals or interferences related to the present application.

III. STATUS OF THE CLAIMS

The application was filed on 17 November 2005 with claims 1-17. A preliminary amendment was filed to deal with multiple claim dependencies and to add new claim 18. In response to the office Action of October 14, 2008, claim 15 was cancelled in an amendment filed January 14, 2009. Claims 14, 17 and 18 were deemed allowed by the Examiner in the office action dated April 26, 2010.

Claims 1-13 and 16 are presented in this appeal.

Claims 1-2, 5-8, 11-13 and 16 stand rejected under 35 USC §102.

Claims 3, 4, 9-10 and 12 stand rejected under 35 USC §103.

No appeal is brought in respect of claims 14, 17 and 18 as they have been deemed allowable.

IV. STATUS OF AMENDMENTS

No amendment after final was filed. All amendments filed prior to the final rejection have been entered.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The pending claims, presented on appeal, are directed to a building construction which has a main portion, a roof portion and a floor portion, the roof and floor portions being attached to the main portion by way of pivot connections. The building construction is formed so that it can be arranged substantially in the shape of a box-like freight container in which the roof portion and/or the floor portion provide(s) structural integrity. The structural integrity is sufficient so that the building construction can be picked up by a crane, and/or arranged in a freight vehicle with a normally loaded freight container on top of it, without causing structural damage to the building construction. The building construction is also formed so that it can be freighted and subsequently assembled by swinging the floor and roof portions out from the main portion by ay of the pivot connections so that the roof and floor portions become at least part of the roof and floor of the assembled building construction.

Independent claim 1 of the present application is supported by the specification, wherein it stated, for example, in the following paragraphs ([0003] and [0015]) of the published application as follows:

[0003] According to one aspect of the invention there is provided a building construction having a main portion, a roof portion, and a floor portion, the roof portion and the floor portion each being attached to the main portion by way of a respective pivot connection or connections, the building construction being formed so that the main portion, the roof portion and the floor portion can be arranged with respect to one another such that the building construction is substantially in the shape of a box-like freight container in which the roof portion and/or the floor portion provide(s) structural integrity, the structural integrity being such that the building construction can be picked up by a crane, and/or arranged in/on a freight vehicle with a normally loaded freight container on top of it, in either case without causing structural damage to the building construction, and wherein the building construction can, after being freighted to a desired site, be assembled by swinging the roof portion out from the main portion, and by swinging the

floor portion out from the main portion, not necessarily in that order, but in each case by way of the pivot connections, such that the roof and floor portions become at least part of the roof and floor of the building construction respectively when the building construction is installed on site.

[0015] According to a further aspect of the invention there is provided a building construction having a main portion, a roof portion, and a floor portion, the roof portion and the floor portion each being attached to the main portion by way of a respective pivot connection or connections, the building construction being formed such that the main portion, the roof portion and the floor portion can be arranged with respect to one another such that the building construction is substantially in a disassembled box-like shape which can be freighted to a desired site, the building construction being formed such that when it is on site it can be assembled by swinging the roof portion out from the main portion, and by swinging the floor portion out from the main portion, not necessarily in that order, but in each case by way of the respective pivot connections, such that the roof and floor portions become at least part of the roof and floor of the building construction respectively when the building construction is installed on site, the building construction being formed such that when the roof portion is swung out to an installed position by way of its pivot connection the position of contact between the roof portion and the main portion is inherently overhung on both sides of that position of contact by the roof portion to substantially assist in resisting rain water entering the building construction when the building construction is completely installed. In this aspect of the invention the building construction may incorporate any or all of the other features, abilities, and arrangements mentioned previously.

Independent claim 14 of the present application is supported by the specification, wherein it stated, for example, in the following paragraphs ([0003], [0006], [0007], and [0015]) of the published application as follows:

[0003] According to one aspect of the invention there is provided a building construction having a main portion, a roof portion, and a floor portion, the roof portion and the floor portion each being attached to the main portion by way of a respective pivot connection or connections, the building construction being formed so that the main portion, the roof

portion and the floor portion can be arranged with respect to one another such that the building construction is substantially in the shape of a box-like freight container in which the roof portion and/or the floor portion provide(s) structural integrity, the structural integrity being such that the building construction can be picked up by a crane, and/or arranged in/on a freight vehicle with a normally loaded freight container on top of it, in either case without causing structural damage to the building construction, and wherein the building construction can, after being freighted to a desired site, be assembled by swinging the roof portion out from the main portion, and by swinging the floor portion out from the main portion, not necessarily in that order, but in each case by way of the pivot connections, such that the roof and floor portions become at least part of the roof and floor of the building construction respectively when the building construction is installed on site.

[0006] Optionally the roof portion or portions can be outside of the respective floor portion or portions, as the case may be, when the building construction is in a disassembled state.

[0007] Optionally the floor portion or portions can be outside of the respective roof portion or portions, as the case may be, when the building construction is in a disassembled state.

[0015] According to a further aspect of the invention there is provided a building construction having a main portion, a roof portion, and a floor portion, the roof portion and the floor portion each being attached to the main portion by way of a respective pivot connection or connections, the building construction being formed such that the main portion, the roof portion and the floor portion can be arranged with respect to one another such that the building construction is substantially in a disassembled box-like shape which can be freighted to a desired site, the building construction being formed such that when it is on site it can be assembled by swinging the roof portion out from the main portion, and by swinging the floor portion out from the main portion, not necessarily in that order, but in each case by way of the respective pivot connections, such that the roof and floor portions become at least part of the roof and floor of the building construction respectively when the building construction is installed on site, the building construction

being formed such that when the roof portion is swung out to an installed position by way of its pivot connection the position of contact between the roof portion and the main portion is inherently overhung on both sides of that position of contact by the roof portion to substantially assist in resisting rain water entering the building construction when the building construction is completely installed. In this aspect of the invention the building construction may incorporate any or all of the other features, abilities, and arrangements mentioned previously.

Independent claim 18 of the present application is supported by the specification, wherein it stated, for example, in the following paragraphs ([0001], [0003], [0006], [0007], and [0015]) of the published application as follows:

[0001] This invention relates to a building construction. A particularly preferred form of the invention relates to a building construction which is at least initially transportable and substantially in the shape of a freight container, and which can be assembled to provide a shelter, for example a dwelling.

[0003] According to one aspect of the invention there is provided a building construction having a main portion, a roof portion, and a floor portion, the roof portion and the floor portion each being attached to the main portion by way of a respective pivot connection or connections, the building construction being formed so that the main portion, the roof portion and the floor portion can be arranged with respect to one another such that the building construction is substantially in the shape of a box-like freight container in which the roof portion and/or the floor portion provide(s) structural integrity, the structural integrity being such that the building construction can be picked up by a crane, and/or arranged in/on a freight vehicle with a normally loaded freight container on top of it, in either case without causing structural damage to the building construction, and wherein the building construction can, after being freighted to a desired site, be assembled by swinging the roof portion out from the main portion, and by swinging the floor portion out from the main portion, not necessarily in that order, but in each case by way of the pivot connections, such that the roof and floor portions become at least part of the roof and floor of the building construction respectively when the building construction is installed on site.

[0006] Optionally the roof portion or portions can be outside of the respective floor portion or portions, as the case may be, when the building construction is in a disassembled state.

[0007] Optionally the floor portion or portions can be outside of the respective roof portion or portions, as the case may be, when the building construction is in a disassembled state.

[0015] According to a further aspect of the invention there is provided a building construction having a main portion, a roof portion, and a floor portion, the roof portion and the floor portion each being attached to the main portion by way of a respective pivot connection or connections, the building construction being formed such that the main portion, the roof portion and the floor portion can be arranged with respect to one another such that the building construction is substantially in a disassembled box-like shape which can be freighted to a desired site, the building construction being formed such that when it is on site it can be assembled by swinging the roof portion out from the main portion, and by swinging the floor portion out from the main portion, not necessarily in that order, but in each case by way of the respective pivot connections, such that the roof and floor portions become at least part of the roof and floor of the building construction respectively when the building construction is installed on site, the building construction being formed such that when the roof portion is swung out to an installed position by way of its pivot connection the position of contact between the roof portion and the main portion is inherently overhung on both sides of that position of contact by the roof portion to substantially assist in resisting rain water entering the building construction when the building construction is completely installed. In this aspect of the invention the building construction may incorporate any or all of the other features, abilities, and arrangements mentioned previously.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-2, 5-8, 11-12 and 16 stand rejected under 35 U.S.C. 102(b) as anticipated by Ciotti (20030185262). Claim 3 stands rejected under 35 U.S.C. 103 (a) as unpatentable over Ciotti in view of Abler (20060185262). Claim 4 stands rejected under 35 USC 103(a) as unpatentable over Ciotti in view of Morris (5966956). Claims 9-10 and 12 stand rejected under 35 U.S.C. 103(a) as unpatentable over Ciotti in view of WO9802626. The premise for all objections is that inherent in *Ciotti* is a structural integrity feature set out in claim 1. Such feature is discussed in detail below.

VII. ARGUMENT

Claim Rejections - 35 USC §102

Claims 1-2, 5-8, 11-13 and 16 stand rejected under 35 USC §102 as anticipated by Ciotti (US 20030051417).

All of the above claims, by reason of the language of claim 1 and the claim dependencies, involve the following features.

> *"... in which the roof portion and/or the floor portion provide(s) structural integrity, the structural integrity being such that the building construction can be picked up by a crane, and/or arranged in a freight vehicle with a normally loaded freight container on top of it, in each case without causing structural damage to the building construction ..."*

We submit that such features are not at all disclosed in *Ciotti*. The authorities are clear that for anticipation the cited reference must disclose the features in question in as complete a detail as is contained in the claim being assessed; *Richardson* v *Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). In the case of *Ciotti* there is no detail equivalent to the above quoted claim features. It is submitted that in light of this claim 1, and thus all of its dependents, clearly pass the *Richardson* test.

Defining an Invention by what it does

In the final office action the examiner argued that the claim 1 limitation "*the structural integrity being such that the building construction can be picked up by a crane, and or arranged in a freight vehicle...*" is an intended use recitation. The examiner argues that the limitations of being picked up by a crane or arranged in a freight vehicle

do not themselves impart structure to the claimed building construction but rather only convey an intended use of the building.

We respectfully submit that the limitations are clearly not expressed as a mere intended use recitation. In this regard the claim 1 language does not say that the various features are "for use" in a particular manner but rather positively states that the roof and floor portions actually "provide structural integrity". The degree of the structural integrity is then defined in the claim by communicating that it is to a degree "*such that the building construction can be picked up by a crane, and/or arranged in a freight vehicle with a normally loaded freight container on top of it, in each case without causing structural damage to the building construction.*". We submit that the claim 1 language is in each case expressed in positive structural terms rather than as a mere proposed use claims construction.

This aspect of Claim 1 is in effect a claim by result. We submit that in certain situations a claim by result is the only way for a patentee to adequately define an invention in a manner which prevents competitors from unfairly and unduly availing themselves of the patentee's labor. On this issue Board of Appeal decision No. 2009-00391 (McLisky) is helpful. At page 4 of the decision the Board quoted favorably from *In re Swinehart* F.2d 210, 212 (CCPA 1971) as follows:

> *"There is nothing intrinsically wrong with defining something by what it does rather than what it is in drafting patent claims."*
>
> *A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."*

At page 2 of the final office Action the examiner argues that "*Nowhere in the claim or specification does the applicant disclose or suggest any novel or specific structural elements or features that enable the building to have the claimed structural integrity*". However, with the greatest of respect to the examiner, this does not appear to

be an anticipation issue and is thus not a relevant consideration for the purpose of 35 USC §102.

Notwithstanding this we submit that the novelty and inventiveness of the present invention resides, at least in part, in the fact that the appellant uses swinging floor and roof portions to impart the structural integrity needed for crane lifting and container stacking. This can be done in any way that the skilled artesian sees fit based on his or her normal training in engineering. With respect to this aspect of the claimed invention, it is the "idea" of using the swinging roof and floor portions for the structural integrity feature that is novel, regardless of the particular manner in which this is brought into effect. It is submitted that a normally skilled structural engineer would have no difficulty implementing the invention, i.e. once armed with the "idea" disclosed in the specification.

Features Not Inherent

At page 2 of the final office action the examiner comments that "*The fact that a prior art reference does not explicitly state that it is capable of a certain use with[out] damage or destruction does not render the prior art device incapable of that certain use.*". As a principle of law we accept this statement. The examiner is in effect suggesting that while *Ciotti* does not specifically disclose the above features they are nonetheless inherent in *Ciotti*. While we agree with the legal principle, we submit that in this case the facts are that *Ciotti* does not provide a factual basis, i.e. given its absence of information, to enable the principle to have relevance.

We respectfully submit that *Ciotti* is very clearly only a top level or generalised disclosure. It omits many details of the makeup of the building because they are clearly not important to the underlying idea or principle that *Ciotti* claims protection for. This is clear, for example, because the *Ciotti* drawings are only conceptual. They show little other than the position of walls when in an assembled and disassembled state. Among other reasons, because *Ciotti* is only a generalised or generic disclosure one cannot

reasonably infer anything about its particular structural or bracing bracing features. They are features left to the skilled artesian to implement as he or she sees fit, based on that person's normal engineering skills. Bracing in *Ciotti* could, for example, be achieved by a series of temporary posts or pillars which are set in place during transport and latter unbolted, etc. A further alternative would be to run a substantial lintel or beam down the sides of the central box like unit in *Ciotti*. The options are many and varied and so we submit that **it cannot be inferred that structural integrity is achieved in *Ciotti*, if at all, in the manner claimed by the present Appellant.** We respectfully submit that the examiner's objection is at best speculative and speculation is not a proper basis for raising issues under 35 USC §102. In this regard we again refer to the very helpful comments by the Board of Appeals in its decision No. 2009-00391 (McLisky) where, at page 4, it stated (emphasis added):

> *"The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness. In re Napier, 55 F.3d 610, 613 (Fed. Cir. 1995).*
>
> *However the fact that a certain result or characteristic may occur or be present in the prior art is **not** sufficient to establish inherency of that result or characteristic. See In re Rijckaert, 9 F.3d 1531, 1534 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessiraily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82 (CCPA 1981).*
>
> > *To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is **necessarily present** in the thing described in the reference, and that it will be so recognised by persons of ordinary skill. Inherency, however, may **not be established by probabilities or possibilities**. There mere fact that a certain thing may result from a given set of circumstances is **not** sufficient.*

We respectfully submit that the rejection is in essence only based on the possibility that in *Ciotti* the moving parts **may** provide the claimed structural integrity feature and, as per the quoted above, a mere possibility is not sufficient for anticipation, or indeed for obviousness. Here, the Examiner has failed to establish "*that the missing descriptive matter is* ***necessarily present*** *in the thing described in the reference, and that it will be so recognised by persons of ordinary skill.*"

At page 3 of the final office action the examiner argues that "*Absent any showing that one construction is capable of something that a similar construction is not capable of it is to be understood that the two constructions are capable of the same uses whether expressly disclosed as capable of that use or not*". We respectfully submit that this statement by the examiner, unsupported by reference to any authorities, perhaps most clearly reveals what we say is the flaw of the objection. The objection essentially depends on the examiner overlooking the structural integrity feature in claim 1, or alternatively inferring that feature into *Ciotti* even though *Ciotti* makes no mention of it. The premise for the examiner's rejection appears to be that to obviate anticipation the Appellant must show how the building of claim 1 delivers structural integrity. However we submit that it is not the function of a claim to show how to do something, it is rather the function of a claim to delineate the monopoly sought. In this regard we again refer to the dicta of Board of Appeals decision No. 2009-00391 (McLisky) page 4, where it was said:

> *"There is nothing intrinsically wrong with defining something by what it does rather than what it is in drafting patent claims."*

Again, the invention in part resides in the idea of using the moveable roof and floor portions in the manner claimed, and not the particulars of how this is carried out. The particulars can vary from artesian to artesian who, applying normal structural engineering skills, would have no difficulty implementing the concept (i.e. once informed of the underlying idea). In any case we again

respectfully submit that the issue of how the invention is implemented is not part of the 35 USC §102 inquiry.

In the final office action the examiner referred to paragraph 0030 of *Ciotti* and points out that there is discussion that the construction could be multi-level, with one container stacked on top of the other. However we respectfully submit that this is unhelpful to the inquiry because there is no disclosure in *Ciotti* as to just what provides strength to enable such stacking, etc. It is a detail left to the artesian to solve as he or she sees fit and thus the examiner is only able to speculate that it may possibly be done in the manner claimed. Again, in the words quoted from Board of Appeals decision No. 2009-00391 (McLisky); "*Inherency, however, may not be established by probabilities or possibilities. There mere fact that a certain thing may result from a given set of circumstances is* ***not*** *sufficient*".

Claims 2, 5-8, 11-13 and 16

As to claims 2, 5-8, 11-13 and 16, all depend on claim 1 as thus include the feature discussed above, and as that feature is not fulfilled by *Ciotti*, we respectfully submit that the anticipation objections to claims 2, 5-8, 11-13 and 16 are incorrect for at least the same reasons given in relation to claim 1.

Appellant, therefore, requests that this rejection be reversed and the claims found not to be anticipated by Ciotti.

Claim Rejections - 35 USC §103(a)

All of the rejections under 35 USC 103(a) rely, initially on the Ciotti reference discussed in detail above. Each of these rejections depend on the incorrect premise that *Ciotti* inherently teaches the structural integrity feature discussed above in relation to 35 USC §102 (alleged anticipation). We respectfully submit that as that feature is absent from *Ciotti* it necessarily follows that all of the rejections under 35 USC §103 based on Ciotti are flawed as there is an element required by the claims that are not taught or suggested by the prior art relied upon by the Examiner. We submit that there is nothing

in the cited references, when taken alone or in combination, which teaches, suggests or implies a building having the features of claim 1 and in particular the structural integrity feature. It is a claim limitation not disclosed in any of the references and as such we respectfully submit there is no prima facie basis for the objection (ie not all claim limitations taught).

Rejection over Ciotti in view of Abler (20060185262):

The Examiner acknowledges that Ciotti is silence with regard to locking means for the floor and wall portions when they are in a substantially vertical orientation in the disassembled state. However, the Examiner urges that Abler discloses a similar building construction having hinged wall portions for forming an expanded floor where in a closed position the building is an ISO shipping container, and further discloses that the portions having locking means for freighting.

The Examiner concludes that it would have been obvious to modify the building of Ciotti to have the locking means of Abler to provide a secure container for shipping.

Appellant would initially note the difference in the construct of Ciotti and that of Abler. Clearly the construct of Ciotti includes, in each disclosed construct, multiple portions, beyond a roof and floor as claimed, connected to the individual sides of the center portion of the construct. Abler reasonably appears to disclose a single roof and/or floor portion for each construct or at least each side of the center portion. It appears reasonable that the difference could eliminate the need in the Ciotti construct for a locking mechanism since the multi paneled system itself may provide the basis for keeping the various elements of the construct in place while disassembled. What is clear is that there is no suggestion in Ciotti for a need or advantage to include such a locking mechanism in the construct. Thus, the question becomes why incorporate a limitation or element into the construct if it is not needed. That Abler would suggest such a need does not

necessarily carry over to all such constructs and is not clearly applicable to the construct of Ciotti.

The test of obviousness is not whether something could be done. The mere fact that something could be done is not the standard of obviousness under 35 U.S.C. § 103. The prior art must suggest the desirability of such a combination or modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Further, "obviousness requires a suggestion of all limitations in a claim." CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing In re Royka, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, "*there must be some articulated reasoning* with some rational underpinning to support the legal conclusion of obviousness." KSR Int'l v. *Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

Here, the combination of Ciotti and Abler fail to account for the structural integrity limitation. Further, the prior art does not readily suggest why one would modify the construct of Ciotti with the locking mechanism of Abler when Ciotti does not suggest the need for such locking of the various components.

Thus, appellant would request reversal of this ground of rejection.

Rejection over Ciotti in view of Morris (5966956):

With regard to this ground of rejection, the appellant would again note that Morris fails to provide that which is additionally missing from the Ciotti disclosure. Claim 4 depends on claim 1 and therefore includes the limitation relating to the structural integrity as discussed above. Neither Ciotti nor Morris disclose or suggest this limitation. As noted in the arguments relative to the previous rejection under 35 U.S.C. 103, the prior art must account for each and every

limitation presented in the claim. Since the two references fail to do so, they do not provide an adequate basis for rejecting the claims under 35 U.S.C. 103(a).

Appellant request reconsideration and withdrawal of this rejection.

Rejection over Ciotti in view of WO 9802626:

Claims 9-10 and 12 stand rejected as being unpatentable over the combination of Ciotti and the WO 9802626 patent.

While citing Ciotti as previously discussed, the Examiner acknowledges that Ciotti "does not disclose a removable corner protector arranged over at least part of an external edge or along a different external edge of the disassembled construction to provide a measure of protection and/or strength when it is being transported." However, the Examiner cites the WO 9802626 patent as disclosing a foldable, portable building construction comprising removable corner protector 26 to aid in moving the building when being transported. The Examiner concludes that it would have been obvious to modify the construction of Ciotti to include the corner protectors of WO982626 to aid in safely and efficiently transporting the construction, such that the building construction can, when in a disassembled state, be picked up by the crane at or adjacent the four corners of the building construction without causing structural damage thereto.

Appellant would initially note that there is nothing that would suggest the need in the construct of Ciotti for such corner protectors as urged by the Examiner. Further, the appellant would note that the teaching of the WO9802626 patent actually supports appellant's previous arguments as presented relative to the rejection of claim 1. In appellant's invention the "removable corner protectors" are stated to **protect and add** strength to the structure. (See Spec. page 9, lines 4-6). According to the WO9802626 patent the corner framing described is intended for "use in carrying and facilitating loading and unloading of the container-sized collapsed

building" (See page 9, lines 26-33 in discussing connectors 26 of Fig. 16). Clearly, this reasonably suggests that the WO9802626 patent does not provide that which is missing from the disclosure of Ciotti, i.e. a structural integrity which would permit the construct to be moved, stacked and loaded without damage even in the absence of corner framing devices. There is nothing in Ciotti which would suggest the need for additional structure to assist in the moving and loading of the disassembled construct. It remains that the teachings of the two references find structure only when viewed through the teaching and claims of the present invention.

For these reasons, appellant would urge that the combination of Ciotti and the WO9802626 patent do not account for each and every limitation of the claimed invention, since claims 9-10 and 12 depend from claim 1 and do not readily suggest the specific claim limitation of these claims. Appellant requests reversal of the present rejection.

GENERAL

We respectfully submit that the corresponding Australian and New Zealand cases have proceeded to grant of patent. The granted claims may be viewed online at the respective Patent Office web site links indicated below. It is submitted that the grant decisions in Australia and New Zealand are at least persuasive in favor of the present US case.

Country	Number	Link
New Zealand	532620	http://www.iponz.govt.nz/cms/banner_template/IPPATENT
Australia	2005220275	http://pericles.ipaustralia.gov.au/aub/pdf/nps/2007/0215/2005220275B2/2005220275.pdf

VIII. CLAIMS APPENDIX

1. **(ORIGINAL)** A building construction having a main portion, a roof portion, and a floor portion, the roof portion and the floor portion each being attached to the main portion by way of a respective pivot connection or connections, the building construction being formed such that the main portion, the roof portion and the floor portion can be arranged with respect to one another such that the building construction is substantially in the shape of a box-like freight container in which the roof portion and/or the floor portion provide(s) structural integrity, the structural integrity being such that the building construction can be picked up by a crane, and/or arranged in a freight vehicle with a normally loaded freight container on top of it, in either case without causing structural damage to the building construction, and wherein the building construction can be, after being freighted to a desired site, assembled by swinging the roof portion out from the main portion, and by swinging the floor portion out from the main portion, not necessarily in that order, but in each case by way of the pivot connections, such that the roof and floor portions become at least part of the roof and floor of the building construction respectively when the building construction is installed on site.

2. **(ORIGINAL)** A building construction according to claim 1, wherein there is a second roof portion and a second floor portion arranged and able to function in similar fashion to the first mentioned roof and floor portions but at an opposite side of the main portion to the first mentioned roof and floor portions.

3. **(PREVIOUSLY AMENDED)** A building construction according to claim 1 wherein there is a second roof portion and a second floor portion arranged and able to function in similar fashion to the first mentioned roof and floor portions but at an opposite side of the main portion to the first mentioned roof and floor portions, and wherein the building construction has locking means for the floor and wall portions such that they can each be locked in a substantially vertical orientation when the building construction is in a disassembled state for freighting.

4. **(PREVIOUSLY AMENDED)** A building construction according to claim 1 wherein there is a second roof portion and a second floor portion arranged and able to function in similar fashion to the first mentioned roof and floor portions but at an opposite side of the main portion to the first mentioned roof and floor portions, and wherein the roof portions can be outside of the respective floor portions when the building construction is in a disassembled state.

5. **(PREVIOUSLY AMENDED)** A building construction according to claim 1, wherein there is a second roof portion and a second floor portion arranged and able to function in similar fashion to the first mentioned roof and floor portions but at an opposite side of the main portion to the first mentioned roof and floor portions, and wherein the floor portions can be outside of the respective roof portions, when the building construction is in a disassembled state.

6. **(PREVIOUSLY AMENDED)** A building construction according to claim 1, wherein there is a second roof portion and a second floor portion arranged and able to function in similar fashion to the first mentioned roof and floor portions but at an opposite side of the main portion to the first mentioned roof and floor portions, and wherein the

building construction is, when in a disassembled state, substantially in the shape of a standard freight container.

7. **(PREVIOUSLY AMENDED)** A building construction according to claim 1, wherein there is a second roof portion and a second floor portion arranged and able to function in similar fashion to the first mentioned roof and floor portions but at an opposite side of the main portion to the first mentioned roof and floor portions, and wherein the building construction is, when in a disassembled state, substantially in the shape of a standard ISO freight container.

8. **(PREVIOUSLY AMENDED)** A building construction according to claim 1, wherein there is a second roof portion and a second floor portion arranged and able to function in similar fashion to the first mentioned roof and floor portions but at an opposite side of the main portion to the first mentioned roof and floor portions, and wherein the building construction is, when in a disassembled state, substantially in the shape of a standard ISO 40 foot freight container.

9. **(PREVIOUSLY AMENDED)** A building construction according to claim 1, wherein there is a second roof portion and a second floor portion arranged and able to function in similar fashion to the first mentioned roof and floor portions but at an opposite side of the main portion to the first mentioned roof and floor portions, and wherein the building construction has, when in a disassembled state, a removable corner protector arranged over at least part of an external edge of the disassembled construction to provide a measure of protection and/or strength to the construction when it is being transported.

10. **(PREVIOUSLY AMENDED)** A building construction according to claim 1, wherein there is a second roof portion and a second floor

portion arranged and able to function in similar fashion to the first mentioned roof and floor portions but at an opposite side of the main portion to the first mentioned roof and floor portions, and wherein the building construction has a plurality of removable corner protectors each arranged along a different external edge of the building construction to provide a measure of protection and/or strength to the building construction when it is being transported.

11. **(PREVIOUSLY AMENDED)** A building construction according to claim 1, including framing and panels wherein the panels can be fitted between parts of the framing to create internal and/or external walls.

12. **(PREVIOUSLY AMENDED)** A building construction according to claim 1, wherein the structural integrity is such that the building construction can, when in a disassembled state, be picked up by the crane at or adjacent four corners of the building construction without causing structural damage to the building construction.

13. **(PREVIOUSLY AMENDED)** A building construction according to claim 1, wherein the building construction is at least partially clad when in a disassembled state.

14. **(ORIGINAL)** A building construction having a main portion, a roof portion, and a floor portion, the roof portion and the floor portion each being attached to the main portion by way of a respective pivot connection or connections, the building construction being formed such that the main portion, the roof portion, and the floor portion can be arranged with respect to one another such that the building construction is substantially in a disassembled box-like shape which can be freighted to a desired site, the building construction being formed such that when it is on site it can be assembled by swinging the roof portion out from the main

portion, and by swinging the floor portion out from the main portion, not necessarily in that order, but in each case by way of the respective pivot connections, such that the roof and floor portions become at least part of the roof and floor of the building construction respectively when the building construction is installed on site, the building construction being formed such that when the roof portion is swung out to an installed position by way of its pivot connection or connections the roof portion is angled upwards away from the main portion so that parts of the roof portion most remote from the main portion are substantially higher than parts of the roof portion immediately adjacent the main portion, and wherein the position of contact between the roof portion and the main portion is inherently covered by the roof portion to substantially assist in resisting rain water entering the building construction when the building construction is completely installed.

15. (PREVIOUSLY CANCELLED)

16. (PREVIOUSLY AMENDED) A building construction according to claim 1, wherein the building construction is certified as a shipping container for use on container ships.

17. (ORIGINAL) A building construction according to claim 14, formed sufficient for ISO certification as a shipping container for use on container ships when in the disassembled box-like shape, and wherein the roof portion provides an outside wall of the box-like shape, the construction being such that in order for assembly to occur the roof portion must be swung out from the main portion before floor portion.

18. (PREVIOUSLY PRESENTED) A building construction having a main portion, two roof portions, two floor portions, beams, wall panels, and windows;

the roof portions and the floor portions each being attached to the main portion by way of respective pivot connections;

the building construction being formed such that the main portion, the roof portions and the floor portions can be arranged with respect to one another such that the building construction is substantially in the shape of a box-like freight container in which the roof portions and the floor portions provide structural integrity, the structural integrity being such that the building construction can be picked up by a crane, and/or arranged in a freight vehicle with a normally loaded freight container on top of it, in either case without causing structural damage to the building construction;

and wherein the building construction can be, after being freighted to a desired site, assembled by swinging the roof portions out from the main portion, and by swinging the floor portions out from the main portion, not necessarily in that order, but in each case by way of the pivot connections, such that the roof and floor portions are supported by the beams and become at least part of the roof and floor of the building construction respectively when the building construction is installed on site;

the assembled disposition being such that for each roof portion parts of the roof portion most remote from the main portion are substantially higher than parts of the roof portion immediately adjacent the main portion,

the building construction also being such that the wall panels and windows are adapted for fitting between the beams and the roof and floor portions to provide weather proofing for the assembled building construction after the floor and roof portions have been swung out and after the beams have been secured at extremities of the roof and floor sections.

IX EVIDENCE APPENDIX

None. No evidence Exhibits are submitted with this Brief on Appeal.

X. RELATED PROCEEDING APPENDIX

None. There are no related appeals or interferences.